

Docket No.: 5098-0101PUS1
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Aurelio ROMEO

Application No.: 10/524,014

Confirmation No.: 7574

Filed: February 8, 2005

Art Unit: 1761

For: TOMATO PRODUCTS

Examiner: Kelly Jo Mahafkey

REPLY TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the Restriction Requirement dated December 21, 2005, the following remarks are respectfully submitted in connection with the above-identified application.

This reply includes: Remarks.

REMARKS

The Examiner has required restriction under 35 U.S.C. § 121 and § 372 on the ground that the “inventions or groups of inventions (which) are not so linked as to form a single general inventive concept under PCT Rule 13.1.” In particular, restriction is required between (I) Claims 1-11, drawn to a tomato juice or pastas, and (II) Claims 12-23, drawn to a method of making a tomato serum.

In response, the Applicant hereby elects the invention of claims 1-11 for prosecution on the merits in the present application. This election is made with traverse.

The grounds for traverse are set forth hereinbelow.

In paragraph 4 of the Office Action, the Examiner states that the two inventions do not relate to a single general inventive concept for the following reasons: the special feature linking the two inventions is a tomato paste with 5.5-20 % dry residue and 18-70% of soluble solids, which allegedly does not provide a contribution over the prior art as evidenced by U.S. Patent 5,965,190 of Gallaher et al. The Examiner states that the ‘190 patent discloses at col. 1, lines 34-40 a tomato paste which has less than 18% of soluble solids (8-24% soluble solids). The Examiner has also stated that “By definition a paste contains 32% soluble solids.”

It is to be noted, however, that in claim 1 of the present application the range of 18-70% by weight refers to the amount of water-insoluble solids, not to that of water-soluble solids.

It is to be noted that the disclosure at lines 34-40 in col. 1 of the ‘190 patent discloses the following tomato products:

- Tomato purees, which are concentrates or products (if not concentrated) containing between about 8% to about 24% by weight of tomato solids (lines 34-37) and

- Tomato juice, which contains between about 5% to about 8% by weight of tomato solids (lines 37-40).

Nowhere in the Gallaher '190 patent is it stated that the tomato solids should be intended as being soluble solids, as the Examiner indicates.

Rather, the tomato solids in Gallaher '190 are meant to be the net total tomato solids, as is shown in col. 1, lines 24-25 and lines 28-29, wherein it is disclosed that tomato pastes have a net total tomato solid content of at least 24% by weight and that tomato pastes intended for further processing into other food products generally contain about 30% to about 32% net total tomato solids.

In addition, it is to be noted that in the '190 patent, when reference is made to tomato solids content, it is indicated that this is the "net total tomato solids content"; see col. 3, lines 46-48; col. 4, lines 4-9; col. 6, lines 45-50 and col. 9, lines 17-19.

The net total (emphasis added) tomato solids therefore comprises both soluble and insoluble tomato solids.

Accordingly, the range of 8-24% mentioned by the Examiner refers to the net total solids content, not to the soluble solids content. The Gallaher '190 patent does not mention this factor.

The Examiner should also note that the figure of 32%, mentioned in the last line of paragraph 4, page 2 of the Office Action, in connection with tomato paste, refers to the net total solids content. This is expressly indicated by Gallaher at col. 1, lines 28-29.

Therefore, the Applicant does not understand on which ground the Examiner is relying for the statement that "By definition a paste contains 32% soluble solids."

In view of the above, it is respectfully submitted that the tomato pastes and tomato puree mentioned in the Gallaher '190 patent do not fall within claim 1 of the present application, since

it is not known from the reference, which is the soluble solids or insoluble solids content of the products.

It is further noted that no method of preparation is mentioned in the '190 patent for said tomato pastes or puree. Therefore, one skilled in the art is even unable to know the quantities of soluble-insoluble solids content of said prior art preparations.

It is thus believed that the election/restriction requirement should be withdrawn, since claim 1 of the present application does provide a contribution over the prior art Gallaher '190 patent cited by the Examiner, since Gallaher does not indicate or suggest any figure for the quantities of tomato soluble-insoluble solids.

The Applicant has found that tomato products which do not need either dilution or concentration before their use, for instance in foods, can also be used as such as foods and have an improved saucing power and improved organoleptic properties (i.e., devoid of any caramel taste, bitter taste, cooking aroma or sour taste; note page 3, lines 16-22 of the present specification).

It is again emphasized that in order to have tomato products with the above combination of properties, the soluble/insoluble solids content should fall within the limits of the present invention. No mention or suggestion of this fact is to be found in the Gallaher '190 patent.

In view of these remarks, action on the merits of claims 1-11 is respectfully requested. Since process claims 12-23 are intertwined with the inventive concepts set forth in claims 1-11, action on the merits of process claims 12-23 is also requested.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Raymond C. Stewart, Registration No 21,066 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to our Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

Dated: January 23, 2006

Respectfully submitted,

By 

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